

REMARKS

Claims 9-13 and 19-46 were pending in the Application. Claim 9 is an independent claim and claims 10-13 and 39-41 depend there from. Claim 19 is an independent claim and claims 20-26 and 42-46 depend there from. Claim 27 is an independent claim and claims 28-38 depend there from. Claims 1-8 and 14-18 were previously canceled. Claims 19, 32 and 45 are currently amended. The Applicant respectfully requests that the application be reconsidered in view of the amendments set forth above and the following remarks.

Claim Objections

On page 2 of the Office Action, claim 32 was objected to for minor informalities. The Applicant respectfully traverses the objection, however, in order to advance prosecution in the application, the Applicant has amended claim 32 to correct the noticed minor informalities. The Applicant respectfully asserts that the minor amendment to claim 32 does not alter the scope of the claim as originally presented, but rather corrects a typo. The Applicant believes the amendment to claim 32 has overcome the noticed minor informalities and therefore respectfully requests that the objection to claim 32 be withdrawn.

Rejections Under 35 U.S.C. §101

On page 2-3 of the Office Action, claims 9-13 were rejected under 35 U.S.C. §101 as being non-statutory subject matter. The Applicant respectfully traverses the rejections for at least the following reasons.

35 U.S.C. §101 states the “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” (35 U.S.C.

§101). Claim 9 is directed to “[a] modem comprising...” and claims 10 through 13 are directed to “[t]he modem of claim 9...” (See Applicant’s claims 9-13). The Applicant appreciates the Examiner’s recognition that “[c]laims 9-13 are directed to modems.” (Office Action, Page 3, Line 1). Clearly, a modem is a “machine” and/or “manufacture” under 35 U.S.C. §101. Thus, claims 9-13, which the Examiner acknowledges are “directed to modems,” are a “machine” and/or “manufacture” under 35 U.S.C. §101 and therefore, constitute statutory subject matter. Because claims 9-13 are directed “machine” and/or “manufacture,” claims 9-13 are statutory subject matter under 35 U.S.C. §101 and therefore, rejections of claims 9-13 under 35 U.S.C. §101 cannot be maintained.

Although irrelevant to the analysis under 35 U.S.C. §101 because the claimed modem is clearly statutory subject matter, the Office Action makes various statements asserting that the “first input,” “second input” and “recording module” limitations of independent claim 9 are “software *per se*,” “functional descriptive material *per se*,” “computer listing *per se*,” etc. The Applicant disagrees with the Office Action’s characterization of the claim elements. For example, with regard to “[a] modem comprising...a first input that operates to receive information from a first device that is utilizing the modem to communicate with a second device through a communication network,” the first input is clearly the structure within the modem that operates to receive information from a first device. “[A] first input” is not a function. Rather, “operat[ing] to receive information” is a function. The function of “operat[ing] to receive information” is performed by the structure, “a first input.” Similarly, “a second input” is the structure within the modem that performs the function of “operat[ing] to receive information.”

Additionally, “a recording module” is the structure within the modem that performs the function of “operating to cause input information...to be recorded.” The Office Action cites to Paragraph 21 of Applicant’s specification to show that the recording module may include hardware, software, or a combination thereof. However, although the recording module “may include...software,” that does not mean the recording module is software. Rather, as shown in the very next sentence of the Applicant’s specification, “a processor on the communication device 101 may execute recording platform 103 instructions to cause the digitized input samples

105, input data 107 and commands 106 to be stored as recorded input samples, input data and commands 104.” (Applicant’s Specification, Paragraph 21). Thus, although the recording module may include software, the recording module is structure that performs the function of “operat[ing] to cause input information...to be recorded,” as set forth in Applicant’s claim 1.

Further, even if “a first input,” “a second input” and/or “a recording module” were functional limitations, MPEP 2173.05(g) states that “[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).” (MPEP 2173.05(g)).

Rejections Under 35 U.S.C. §102(e) – Kaler

In point 10 on pages 4 through 6 of the non-final Office Action, independent claim 9 and dependent claims 11-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Kaler et al. (U.S. Patent No. 6,467,052, hereinafter “Kaler”). Without conceding that Kaler qualifies as prior art under 35 U.S.C. §102(e), the Applicant respectfully traverses the rejections for at least the following reasons.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 9, the Applicant respectfully submits that Kaler fails to teach, suggest, or disclose, for example, “[a] modem comprising...a recording module communicatively coupled to the first input and the second input that operates to cause input information arriving at

one or both of the first input and the second input during real-time operation of the modem to be recorded for subsequent non-real-time analysis,” as set forth in Applicant’s independent claim 9.

The Response to Arguments section of the non-final Office Action states that “the plain language of the claim does not suggest that the recording module has to reside on the modem. The claim does not expressly recite that the recording module is residing on the modem, but rather as being a functional component of the modem. Thus, there is no relationship indicated by the claim language that the modem and the recording module are part of the same physical unit.” (Office Action, Page 26, Lines 10-14). The Applicant disagrees with the Office Action’s characterization of Applicant’s claim. Independent claim 9 sets forth “[a] modem comprising...a recording module...” The term “comprising” means “including the following elements but not excluding others.” Thus, “[a] modem comprising...a recording module...” is a modem that includes a recording module but could also include other elements. If the recording module does not reside on the modem, then the modem does not comprise a recording module. Therefore, not only does the plain language of the claim suggest that the recording module has to reside on the modem, the only reasonable interpretation of the claim is that the recording module resides on the modem because if the recording module does not reside on the modem, then the modem does not comprise a recording module.

Further, Applicant disagrees with the Office Action’s assertion that the recording module is a “functional component of the modem.” (Office Action, Page 26, Lines 11-12). As discussed in more detail above with regard to the rejection under 35 U.S.C. §101, “a recording module” is the structure within the modem that performs the function of “operating to cause input information...to be recorded.”

Kaler fails to disclose “[a] modem comprising...a recording module...,” as set forth in Applicant’s independent claim 9. Because the Office Action has failed to show “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” as required for an anticipation rejection under MPEP 2131, the rejection under 35 U.S.C. § 102(e) cannot be maintained.

Further, Kaler fails to disclose “**a recording module**...that operates to cause **input information** arriving at one or both of the first input and the second input during real-time operation of the modem **to be recorded**,” as set forth in Applicant’s independent claim 9. Kaler’s VSA is not a recording module but rather analyzes collected events. Kaler’s LEC is not a recording module but rather collects events received from IECs and DEC’s. Kaler’s IECs and DEC’s are not recording modules but rather, “[t]he function of an IEC is to **monitor** the executing process for particular situations that occur which the developer wants to be monitored and to **create an ‘event’** that can be captured and later analyzed. The function of a DEC is similar to that of an IEC, but it **monitors** some aspect of the system operation that the developer wants to be monitored on a periodic or time basis and **creates an ‘event’** that can also be captured and later analyzed.” (Col. 4, Lines 4-12 (emphasis added)). Kaler’s **monitoring and creating events** is different than **recording “input information** arriving at one or both of the first input and the second input during real-time operation of the modem,” as set forth in Applicant’s independent claim 9. Because the Office Action has failed to show “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” as required for an anticipation rejection under MPEP 2131, the rejection under 35 U.S.C. § 102(e) cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the Kaler reference fails to teach, suggest, or disclose Applicant’s invention as set forth in claim 9. The Applicant believes that claim 9 is allowable over Kaler. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-13 and 39-41 depend either directly or indirectly from independent claim 9. Because claims 10-13 and 39-41 depend from claim 9, Applicant respectfully submits that claims 10-13 and 39-41 are allowable over the Kaler reference, as well. The Applicant respectfully requests, therefore, that the rejection of claims 9, 11 and 12 under U.S.C. §102(e), be withdrawn.

Rejections Under 35 U.S.C. §103(a) – Kaler

Claims 13, 19, 20 and 22-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaler. The Applicant respectfully traverses the rejection for at least the following reasons.

Regarding claim 13, as discussed in more detail above, Kaler fails to disclose “[a] modem comprising...a recording module communicatively coupled to the first input and the second input that operates to cause input information arriving at one or both of the first input and the second input during real-time operation of the modem to be recorded for subsequent non-real-time analysis.” Thus, Kaler also fails to disclose a modem comprising...a recording module communicatively coupled to the first input and the second input that operates to cause input information arriving at one or both of the first input and the second input during real-time operation of the modem to be recorded for subsequent non-real-time analysis, wherein the modem comprises an ADSL modem.

Also, please note that nowhere in Kaler is there any mention of the term “communication device.” Further, nowhere in the Applicant’s claims does the term “communication device” appear. **Thus, the Applicant asks that the Examiner clarify why the “communication device” term is being inserted by the Examiner in Applicant’s claims. Additionally, the Applicant respectfully requests that the Examiner examine the claims as written.**

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant’s claim 9 is allowable over the Kaler reference, alone or in combination with any other reference. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-13 and 39-41 depend either directly or indirectly from independent claim 9. Because claims 10-13 and 39-41 depend from claim 9, Applicant respectfully submits that claims 10-13 and 39-41 are allowable over the Kaler reference, as well. The Applicant respectfully requests, therefore, that the rejection of claim 13 under U.S.C. §103(a), be withdrawn.

Regarding claim 19, Applicant respectfully submits that Kaler fails to teach, suggest, or disclose at least, for example, “a memory comprising input information that was recorded by a

recording module residing on a modem during real-time operation of the modem,” as set forth in Applicant’s amended, independent claim 19.

As mentioned above, Kaler fails to disclose “a memory comprising input information that was recorded by a recording module residing on a modem during real-time operation of the modem,” as set forth in Applicant’s amended, independent claim 19. Kaler’s VSA is not a recording module but rather analyzes collected events. Kaler’s LEC is not a recording module but rather collects events received from IECs and DEC’s. Kaler’s IECs and DEC’s are not recording modules but rather, “[t]he function of an IEC is to monitor the executing process for particular situations that occur which the developer wants to be monitored and to create an ‘event’ that can be captured and later analyzed. The function of a DEC is similar to that of an IEC, but it monitors some aspect of the system operation that the developer wants to be monitored on a periodic or time basis and creates an ‘event’ that can also be captured and later analyzed.” (Col. 4, Lines 4-12 (emphasis added)). Kaler’s monitoring and creating events is different than “input information that was recorded by a recording module residing on a modem,” as set forth in Applicant’s amended, independent claim 19. Further, even if Kaler’s VSA, LEC, IEC and/or DEC was a recording module (which they are not), nowhere in Kaler is there any indication that the VSA, LEC, IEC and/or DEC “resid[es] on a modem.”

Also, please note that nowhere in Kaler is there any mention of the term “communication device.” Further, nowhere in the Applicant’s claims does the term “communication device” appear. Thus, the Applicant asks that the Examiner clarify why the “communication device” term is being inserted by the Examiner in Applicant’s claims. Additionally, the Applicant respectfully requests that the Examiner examine the claims as written.

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant’s claim 19 is allowable over the Kaler reference, alone or in combination with any other reference. Applicant respectfully submits that claim 19 is an independent claim, and that claims 20-26 and 42-46 depend either directly or indirectly from independent claim 19. Because claims 20-26 and 42-46 depend from claim 19, Applicant respectfully submits that claims 20-26 and 42-46 are allowable over the Kaler reference, as well. The Applicant respectfully requests,

therefore, that the rejection of claims 19-20, 22-26 and 42-46 under U.S.C. §103(a), be withdrawn.

In addition to the reasons for allowability set forth above with regard to claim 45, claim 45 is also allowable at least because Kaler fails to disclose “wherein the model of the modem comprises an actual hardware component that is the same as a hardware component of the modem being modeled.” Page 21 of the Office Action states that “see Figure 14; Column 33: 32-37, “...**an animated application model**, shown generally by reference number 410, includes a machine 404, which is shown coupled functionally to a machine 412, which in turn is coupled to a machine 411.” (Office Action, Page 21, Lines 2-5 (emphasis added)). The animated application model disclosed in Kaler is different than “**the model of the modem comprises an actual hardware component** that is the same as a hardware component of the modem being modeled.” Thus, at least for the above stated reasons, Applicant respectfully submits that Applicant’s claim 45 is allowable over the Kaler reference, alone or in combination with any other reference. The Applicant respectfully requests, therefore, that the rejection of claim 45 under U.S.C. §103(a), be withdrawn.

Turning next to claim 27, Applicant respectfully submits that Kaler fails to teach, suggest, or disclose at least, for example, “operating the modem in real-time to communicatively couple the first device and the second device, the modem comprising a recording module; while operating the modem in real-time, utilizing the recording module to cause the recording of input information input to at least the first and/or second inputs of the modem.”

As mentioned above, Kaler fails to disclose “operating the modem in real-time to communicatively couple the first device and the second device, **the modem comprising a recording module**; while operating the modem in real-time, **utilizing the recording module to cause the recording of input information input to at least the first and/or second inputs of the modem**,” as set forth in Applicant’s independent claim 27. Kaler’s VSA is not a recording

module but rather analyzes collected events. Kaler's LEC is not a recording module but rather collects events received from IECs and DEC's. Kaler's IECs and DEC's are not recording modules but rather, "[t]he function of an IEC is to monitor the executing process for particular situations that occur which the developer wants to be monitored and to create an 'event' that can be captured and later analyzed. The function of a DEC is similar to that of an IEC, but it monitors some aspect of the system operation that the developer wants to be monitored on a periodic or time basis and creates an 'event' that can also be captured and later analyzed." (Col. 4, Lines 4-12 (emphasis added)). Kaler's monitoring and creating events is different than "utilizing the recording module to cause the recording of input information input to at least the first and/or second inputs of the modem," as set forth in Applicant's independent claim 27. Further, even if Kaler's VSA, LEC, IEC and/or DEC was a recording module (which they are not), nowhere in Kaler is there any indication that "the modem compris[es]" a VSA, LEC, IEC and/or DEC.

Also, please note that nowhere in Kaler is there any mention of the term "communication device." Further, nowhere in the Applicant's claims does the term "communication device" appear. **Thus, the Applicant asks that the Examiner clarify why the "communication device" term is being inserted by the Examiner in Applicant's claims. Additionally, the Applicant respectfully requests that the Examiner examine the claims as written.**

Therefore, for at least the above stated reasons, Applicant respectfully submits that Applicant's claim 27 is allowable over the Kaler reference, alone or in combination with any other reference. Applicant respectfully submits that claim 27 is an independent claim, and that claims 28-38 depend either directly or indirectly from independent claim 27. Because claims 28-38 depend from claim 27, Applicant respectfully submits that claims 28-38 are allowable over the Kaler reference, as well. The Applicant respectfully requests, therefore, that the rejection of claims 27-38 under U.S.C. §103(a), be withdrawn.

With regards to claims 39-41, Applicant respectfully submits that Applicant's claim 9 is

allowable over the Kaler reference, alone or in combination with any other reference. Applicant respectfully submits that claim 9 is an independent claim, and that claims 10-13 and 39-41 depend either directly or indirectly from independent claim 9. Because claims 10-13 and 39-41 depend from claim 9, Applicant respectfully submits that claims 10-13 and 39-41 are allowable over the Kaler reference, as well. The Applicant respectfully requests, therefore, that the rejection of claims 39-41 under U.S.C. §103(a), be withdrawn.

In addition to the reasons for allowability set forth above with regard to claim 40, claim 40 is also allowable at least because Kaler fails to disclose “wherein the recording module is integrated into an integrated circuit of the modem.” The Office Action states that “Kaler et al. do not disclose: wherein the recording module is integrated into an integrated circuit of the modem. Official Notice is taken that it is old and well known within the computing art to integrate software into an integrated circuit.” (Office Action, Page 18, Lines 15-19). However, as mentioned above, the recording module is structure that performs the function “operat[ing] to cause input information...to be recorded.” Therefore, Kaler, even if combined with the Examiner’s Official Notice, fails to disclose “wherein the recording module is integrated into an integrated circuit of the modem.” Thus, at least for the above stated reasons, Applicant respectfully submits that Applicant’s claim 40 is allowable over the Kaler reference, alone or in combination with any other reference. The Applicant respectfully requests, therefore, that the rejection of claim 40 under U.S.C. §103(a), be withdrawn.

Rejections Under 35 U.S.C. §103(a) – Kaler in view of Wakasugi

Claims 10 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaler in view of Wakasugi (U.S. Patent No. 6,169,610). The Applicant respectfully traverses the rejection for at least the following reasons. Claims 10 and 21 depend from independent claims 9 and 19, respectively. Applicant believes that claims 9 and 19 are allowable over the proposed combination of references, in that Wakasugi fails to overcome the deficiencies of Kaler, for at least the reasons set forth above. Because claims 10 and 21 depend from independent claims 9

and 19, respectively, Applicant respectfully submits that claims 10 and 21 are allowable over the proposed combination of Kaler and Wakasugi, as well. Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claims 10 and 21 under 35 U.S.C. §103(a) be withdrawn.

The Office Action makes various statements regarding claims 9-13 and 19-46, 35 U.S.C. § 101, 35 U.S.C. § 102(e), 35 U.S.C. § 103(a), the Kaler reference, the Wakasugi reference, Official Notice, one of skill in the art, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicants will not address all of such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 9-13 and 19-46 should the need arise in the future.

Appl. No. 10/767,604
Resp. to non-final Office Action of Aug. 24, 2007
Response dated Feb. 22, 2008

CONCLUSION

Applicant respectfully submits that claims 9-13 and 19-46 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Date: February 22, 2008

Respectfully submitted,

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